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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,531	06/19/2001	Brian McConnell	310/1-25587-039	2612
36614	7590	09/06/2006	EXAMINER	
MANATT PHELPS AND PHILLIPS ROBERT D. BECKER 1001 PAGE MILL ROAD, BUILDING 2 PALO ALTO, CA 94304			BHATIA, AJAY M	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/884,531

Applicant(s)

MCCONNELL ET AL.

Examiner

Ajay M. Bhatia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

Applicant's arguments with respect to claims 6-16 have been considered but are moot in view of the new ground(s) of rejection. Applicant has filed an RCE 7/25/06, with new claims and limitations.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 6-8, and 10-16 are rejected under 35 U.S.C. 102(e) as being 6/19/01 by Capriotti et al. (U.S. Patent 6,748,056).

For claim 6, Capriotti teaches, a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of:

(a) receiving a call in an email server from the user of the portable electronic device; (Capriotti, Col. 4 lines 52-57)

(b) determining if the caller is registered as a user of the email server; (Capriotti, Col. 5 lines 1-13)

(c) obtaining a pre-assigned indicium from the user of the portable electronic device, the message-identifying indicium having been assigned to an email message received by the user of the portable electronic device prior to receipt of the email message by that user; (Capriotti, Col. 10 lines 30-45)

(d) authenticating the message-identifying indicium; (Capriotti, Col. 5, lines 42-65, Col. 10 lines 44-56, Col. 11 lines 46-65)

(e) requesting the caller to record a voice message; (Capriotti, Col. 5, lines 42-65, Col. 10 lines 44-56, Col. 11 lines 46-65)

(f) recording the voice message; (Capriotti, Col. 5, lines 42-65, Col. 10 lines 44-56, Col. 11 lines 46-65) and

(g) transmitting the voice message to the user of the office-based terminal.  
(Capriotti, Col. 5, lines 42-65, Col. 10 lines 44-56, Col. 11 lines 46-65)

For claim 7, Capriotti teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 6, further comprising the step of converting the recorded voice message into a format adapted for attachment to an electronic message. (Capriotti, Col. 5, lines 42-65, Col. 10 lines 44-56, Col. 11 lines 46-65)

For claim 8, Capriotti teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 6, further comprising the steps of playing an error message and terminating the program if the caller is not registered as a user of the email server. (Capriotti, Col. 10 lines 30-45)

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For claim 10, Capriotti teaches, a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of:

- (a) receiving a call in an email server from the user of the portable electronic device; (Capriotti, Col. 4 lines 52-57)
- (b) determining if the caller is registered as a user of the email server; (Capriotti, Col. 5 lines 1-13)
- (c) obtaining a pre-assigned message-identifying code from the caller; (Capriotti, Col. 10 lines 30-45)
- (d) authenticating the message-identifying code; (Capriotti, Col. 5, lines 42-65, Col. 10 lines 44-56, Col. 11 lines 46-65)
- (e) requesting the caller to record a voice message; (Capriotti, Col. 5, lines 42-65, Col. 10 lines 44-56, Col. 11 lines 46-65)
- (f) recording the voice message; (Capriotti, Col. 5, lines 42-65, Col. 10 lines 44-56, Col. 11 lines 46-65 )
- (g) converting the recorded voice message into MP-3 format; (Capriotti, Col. 5, lines 42-65, Col. 10 lines 44-56, Col. 11 lines 46-65) and
- (h) transmitting the voice message to the user of the office-based terminal.  
(Capriotti, Col. 5, lines 42-65, Col. 10 lines 44-56, Col. 11 lines 46-65)

For claim 11, Capriotti teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to

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claim 6, further comprising identifying the user of the portable electronic device by using a Caller ID service. (Capriotti, Col. 10 lines 30-45)

For claim 12, Capriotti teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 6, further comprising if a Caller ID service is not operating, prompting the user of the portable electronic device to enter a personal identification number ("PIN"), and authenticating the PIN to determine whether it is valid. (Capriotti, Col. 10 lines 30-45)

For claim 13, Capriotti teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 6, wherein the pre-assigned message-identifying indicium allows the voice message to be transmitted efficiently to the office-based terminal. (Capriotti, Col. 10 lines 17-29)

For claim 14, Capriotti teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 10, further comprising identifying the user of the portable electronic device by using a Caller ID service. (Capriotti, Col. 10 lines 30-45)

For claim 15, Capriotti teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to

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claim 10, further comprising, if a Caller ID service is not operating, prompting the user of the portable electronic device to enter a PIN, and authenticating the PIN to determine whether it is valid. (Capriotti, Col. 10 lines 30-45)

For claim 16, Capriotti teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 10, wherein the pre-assigned message-identifying indicium allows the voice message to be transmitted efficiently to office-based terminal. (Capriotti, Col. 10 lines 17-29)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capriotti et al. (U.S. Patent 6,748,056).

For claim 9, Capriotti fails to clearly disclose, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 6, further comprising the step of determining if the recorded message is acceptable and if not, recording the message again.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the features, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 6, further comprising the step of determining if the recorded message is acceptable and if not, recording the message again. Because these features are well known in Voice Messaging System. (Avaya Quick Reference Guide for Aria Software "Sending Messages") Capriotti in Col. 5 line 22-29, defines the system as a Voice Messaging platform, therefore it would be obvious to implement features that are common to most voice system which a user (customer) of the voice system would expect.

### ***Conclusion***

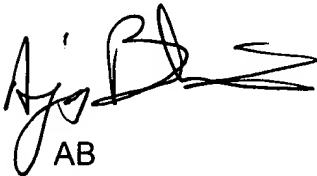
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Notice of references cited (if appropriate).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



AB



Jason Cardone  
Supervisor Patent Examiner  
Art Unit 2145